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EXAMINER

GOFF II, JOHN L

ART UNIT

PAPER NUMBER

1733

DATE MAILED: 05/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/810,794

Applicant(s)

ROMIG ET AL.

Examiner

John L. Goff

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7, 11-18 and 24-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 11-18 and 24-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This action is in response to Amendment B received on 2/25/03. In view of applicants amendment the previous rejections using Williams and Berger et al. are withdrawn.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### *Claim Rejections - 35 USC § 102*

3. Claims 1, 2, 6, 11, 12, 16, 23, 27, and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Heider (U.S. Patent 4,904,324).

Heider is directed to a method of in-mold labeling. Heider teaches a label comprising an inner layer of heat bondable adhesive (i.e. polymeric material), a middle layer of cellular plastic, and an outer layer of a metallic coating with a printed layer (e.g. of indicia) applied thereon (i.e. coupled). Heider teaches a container (e.g. plastic bottle) made of olefin plastics, i.e. semi-permeable plastics. Heider teaches an in-mold labeling process comprising placing the label on the external surface of the container during molding of the container such that the heat from the container melts the inner layer of the label and bonds the label to the container to form a labeled container upon cooling. Heider teaches the label covers an area on the external surface of the container less than the entire external surface area of the container (Figures 1 and 2 and Column 1, lines 18-23 and Column 2, lines 1-5, 18-36 and 59-68 and Column 3, lines 29-32 and 38-41).

*Claim Rejections - 35 USC § 103*

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1, 6, 11, 16, 17, 23, 25-27, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamanaka (U.S. Patent 5,254,302) in view of Heider and Yasuda et al. (U.S. Patent 5,409,754).

The background of Yamanaka is directed to conventional methods of labeling an article. Yamanaka teaches a label comprising an inner layer of heat bondable adhesive (i.e. polymeric material), a middle/base layer of metal foil, and an outer layer of printing (i.e. the printing is attached/coupled to the middle/base layer). Yamanaka teaches an article such as a container made of plastics such as polypropylene and polyethylene, i.e. semi-permeable plastics. Yamanaka teaches a first, in-mold labeling process for applying the label to the container comprising placing the label on the external surface of the container during molding of the container such that the heat from the container melts the inner layer of the label and bonds the label to the container to form a labeled container upon cooling. Yamanaka teaches a second, iron-on labeling process for applying the label to the container comprising placing the label on the external surface of a preformed container and heating the label with an iron such that the heat

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from the container melts the inner layer of the label and bonds the label to the container to form a labeled container upon cooling (Column 1, lines 15-60). Yamanaka is silent as to specifically reciting the label covers an area on the external surface of the container less than the entire external surface area of the container. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to perform the labeling processes taught by Yamanaka using a label having a surface area smaller than the external surface area of the container as it was well known in the art to apply labels such as that taught by Yamanaka in this manner as shown for example by Heider and Yasuda et al. and only the expected results would be achieved.

Regarding claims 17, 25, and 26, it is noted Yamanaka teaches using a low-melting adhesive layer. Absent any unexpected results, one of ordinary skill in the art at the time the invention was made would have readily appreciated determining the optimal melting temperature of the adhesive as it is well known that the melting temperature of the adhesive is a property of the particular adhesive used, and Yamanaka is not limited to any particular adhesive. Furthermore, determining the type of adhesive would require nothing more than ordinary skill and routine experimentation.

Heider is directed to a method of in-mold labeling. Heider teaches a label comprising an inner layer of heat bondable adhesive (i.e. polymeric material), a middle layer of cellular plastic, and an outer layer of a metallic coating with a printed layer (e.g. of indica) applied thereon (i.e. coupled). Heider teaches a container (e.g. plastic bottle) made of olefin plastics, i.e. semi-permeable plastics. Heider teaches an in-mold labeling process comprising placing the label on the external surface of the container during molding of the container such that the heat from the

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container melts the inner layer of the label and bonds the label to the container to form a labeled container upon cooling. Heider teaches the label covers an area on the external surface of the container less than the entire external surface area of the container (Figures 1 and 2 and Column 1, lines 18-23 and Column 2, lines 1-5, 18-36 and 59-68 and Column 3, lines 29-32 and 38-41). Yasuda et al. are directed to a method of in-mold labeling. Yasuda et al. teach a label comprising an inner layer of heat bondable adhesive (i.e. polymeric material), a middle/base layer aluminum, and an outer print layer (i.e. the printing is attached/coupled to the middle/base layer). Yasuda et al. teach an in-mold labeling process comprising placing the label on the external surface of a container during molding of the container such that the heat from the container melts the inner layer of the label and bonds the label to the container to form a labeled container upon cooling. Yasuda et al. teach the label covers an area on the external surface of the container less than the entire external surface area of the container (Figures 1 and 2 and Column 2, lines 53-57 and 59-61 and Column 3, lines 35-38 and Column 4, lines 1-5 and Column 6, lines 48-50 and Column 7, lines 19-28).

6. Claims 2-5 and 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamanaka, Heider, and Yasuda et al. as applied above in paragraph 5, and further in view of the admitted prior art.

Yamanaka, Heider, and Yasuda et al. teach all of the limitations in claims 2-5 and 12-15 as applied above except for a specific teaching of the different types of containers that can be labeled. Absent any unexpected results, it would have been obvious to one of ordinary skill in the art at the time the invention was made to label containers such as plastic bottles, pharmaceutical bottles, IV bags, and food packages using the label and method taught by

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Yamanaka as modified by Heider and Yasuda et al. as it was known in the art to label these products with labels as shown by the admitted prior art.

The admitted prior art is directed to labeling containers wherein the containers include plastic bottles, pharmaceutical bottles, IV bags, food packages, etc. (Specification pages 1 and 2).

7. Claims 7 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamanaka, Heider, and Yasuda et al. as applied above in paragraph 5, and further in view of Kelch et al. (U.S. Patent 6,042,930).

Yamanaka, Heider, and Yasuda et al. teach all of the limitations in claims 7 and 18 as applied above except for a specific teaching of using a base layer of metallized polyester. However, it is noted Yamanaka is not limited to any particular base layer, and Yamanaka suggests the base layer materials include polymeric, paper, metal, etc. One of ordinary skill in the art at the time the invention was made would have readily appreciated using as the base layer of Yamanaka as modified by Heider and Yasuda et al. metallized polyester, i.e. Mylar, as this was a well known base layer material used in heat-activated adhesive labels as shown for example by Kelch et al. and only the expected results would be achieved, i.e. the metallized polyester would give the label similar properties to that of a metal foil.

Kelch et al. are directed to heat-activated adhesive labels for use in labeling containers. Kelch et al. teach the base layer of labels may comprise oriented polyester such as Mylar (Column 2, lines 12-19 and 34-36 and Column 8, lines 21-22).

8. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamanaka, Heider, and Yasuda et al. as applied above in paragraph 5, and further in view of Yoda et al. (U.S. Patent 3,961,009).

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Yamanaka, Heider, and Yasuda et al. teach all of the limitations in claim 24 as applied above except for a specific teaching of cooling the labeled container in a cooling bath. However, it would have been well within the purview of one of ordinary skill in the art at the time the invention was made to cool the labeled container taught by Yamanaka as modified by Heider and Yasuda et al. in a cooling bath or cooling in air as these were well known cooling alternatives in the art as shown for example by Yoda et al.

Yoda et al. are directed to extrusion shaping polymers to form heat resistant articles. Yoda et al. teach cooling the extruded articles using cooled air or a cooling bath (Column 6, lines 19-21).

9. Claims 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamanaka, Heider, and Yasuda et al. as applied above in paragraph 5, and further in view of Swierczek (U.S. Patent 5,024,014).

Yamanaka, Heider, and Yasuda et al. teach all of the limitations in claims 28 and 29 as applied above except for a specific teaching of using a printed layer wherein a bonding agent is required to bond the printed layer to the base layer. One of ordinary skill in the art at the time the invention was made would have readily appreciated incorporating into Yamanaka as modified by Heider and Yasuda et al. a printed layer bonded to the base layer through a bonding agent to apply articles such as attached coasters to the container as suggested by Swierczek.

Swierczek is directed to label for use as a coaster. Swierczek teaches a label comprising an inner adhesive layer and an outer print layer. Swierczek teaches the label can be attached directly to the external surface of a container or the label can be placed over a conventional label



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on the container (Figures 1-6 and Column 2, lines 4-8, 14-16, and 50-54 and Column 3, lines 33-35).

*Response to Arguments*

10. Applicant's arguments with respect to claims 1-7, 11-18, and 23-30 have been considered but are moot in view of the new ground(s) of rejection.

*Conclusion*


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Goff whose telephone number is 703-305-7481. The examiner can normally be reached on M-Th (8 - 5) and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball can be reached on 703-308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



John L. Goff  
May 2, 2003



JEFF H. AFTERGUT  
PRIMARY EXAMINER  
GROUP 1300